

REMARKS

This is a preliminary amendment in the above-identified continuation application. This amendment is also a response to the non-final Official Action mailed September 3, 2003 (Paper No. 2) in the parent patent application (Application No. 10/235,471). Examination of this application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, the claims have been amended. In particular, claims 1, 11, 16, 17, 24-28, 30-32, 38-43 and 46 have been cancelled without prejudice or disclaimer. New claims 47-60 have been added. Thus, claims 1-10, 12-15, 18-23, 29, 33-37, 44, 45 and 47-60 are currently pending for the Examiner's consideration.

In the first Office Action in the parent application (Application No. 10/235,471), claims 1-3, 7-9, 12-15, 17, 18, 22, 29, 31, 32, 36 and 44 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,704,403 to Schwenk et al. and claims 4-6, 10, 16, 19-21, 23, 33-35 and 37 as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Schwenk and U.S. Patent No. to Howlett et al. For at least the following reasons, Applicant would traverse these rejections if these rejections were again made in the present continuation application.

Claim 2 recites:

An ink cartridge refilling station comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from

said supply of ink; and
a user interface for controlling said adding of ink to said ink cartridge.

In contrast, Schwenk does not teach or suggest the claimed “user interface for controlling said adding of ink to said ink cartridge.” Similar subject matter is also recited in other pending claims, for example, claim 18.

Claim 7 recites:

An ink cartridge refilling station comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a cartridge diagnostic unit for evaluating said cartridge prior to refilling said cartridge to determine to what extent said cartridge can be refilled.

In contrast, Schwenk does not teach or suggest the claimed “cartridge diagnostic unit for evaluating said cartridge prior to refilling said cartridge to determine to what extent said cartridge can be refilled.” Similar subject matter is also recited in other pending claims, for example, claim 22.

Claim 44 recites:

A method of adding ink to an ink cartridge, said method comprising:
placing said ink cartridge in a ink cartridge refilling station;
ascertaining information about said ink cartridge; and
if said information about said ink cartridge matches predetermined parameters, refusing to add ink to said cartridge with an automated refilling mechanism of said ink cartridge refilling station.

In contrast, Schwenk does not teach or suggest “refusing to add ink to said cartridge” “if said information about said ink cartridge matches predetermined parameters” as claimed

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, a rejection of the claims described above would be inappropriate if based only on the Schwenk reference.

Claim 10 recites:

An ink cartridge refilling station comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a receipt printer.

In contrast, Schwenk does not teach or suggest the recited "receipt printer." The Office Action seems to suggest that Howlett teaches the claimed receipt printer. However, the Office Action does not indicate how or where Howlett contains such a teaching and Applicant is unable to identify any such subject matter in Howlett.

Claim 4 recites:

An ink cartridge refilling station comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a label reading mechanism for reading an identification label on said ink cartridge.

In contrast, Schwenk fails to teach or suggest a label reading mechanism or identification label on an ink cartridge. Howlett teaches a bar-code on a paint can that

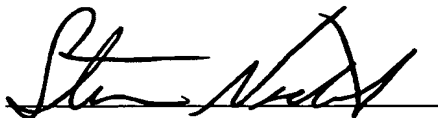
specifies the color or color components of the paint to be mixed in that can. The bar-code taught by Howlett is not an "identification label" that identifies one can of paint from another. Moreover, none of the prior art reference teach or suggest an identification label on an ink cartridge.

Consequently, the combined prior art fails to teach or suggest the claimed identification label on an ink cartridge and a reader for such a label. Similar subject matter is also recited in other pending claims, for example, claims 15, 19, 33 and 36.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, a rejection based on Schwenk in combination with Howlett of the claims mentioned above would be inappropriate.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven L. Nichols', written over a horizontal line.

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